

## **REMARKS**

### **I. PRELIMINARY REMARKS**

Claims 8, 10-12, 14-17 and 23-27 have been amended.<sup>1</sup> No claims have been added or canceled. Claims 8-29 remain in the application. Claims 10, 15, 17, 24 and 27 have been withdrawn from consideration. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes that the Office Action appears to include a typographical error. Specifically, it appears that the first line of paragraph 6 (page 3) of the Office Action should read “claims 8, 9, 11, 13, 14, 16, 18-23, 25, 28 and 29 are rejected ...” and applicant has responded accordingly.

### **II. OBJECTION TO THE SPECIFICATION**

The specification has been objected to under 37 C.F.R. 1.75(d)(1) because the specification does not provide proper antecedent basis for the term “pre-bent portion,” which is recited in the claims. Applicant respectfully submits that the objection has been obviated by the amendment to claims 8, 10-12, 14, 15 and 23-27. More specifically, the claims now refer to “a preshaped portion having a predefined bend” or “the preshaped portion.” [See, for example, the specification at page 17, line 13 to page 19, line 33.] Applicant further submits that this amendment, which has been solely in order to overcome the formalistic objection under 37 C.F.R. 1.75(d)(1), does not narrow the scope of the claims.

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<sup>1</sup> Claims 16 and 17 have been amended in order to correct a typographical error.

### **III. DOUBLE PATENTING REJECTIONS**

Claims 8, 9, 11, 14, 16, 18-23, 25, 26, 28, 29 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over various claims from U.S. Patent Nos. 5,820,591; 6,413,234; 6,613,046 and 6,645,200. Applicant respectfully submits that the obviousness-type double patenting rejections have been obviated by the Terminal Disclaimer attached hereto.<sup>2</sup>

### **III. PRIOR ART REJECTIONS**

#### **A. The Rejections**

Claims 8, 9, 11, 13, 14, 16, 18-23, 25, 28 and 29 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,322,064 to Lundquist (the Lundquist '064 patent). Claims 12 and 26 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Lundquist '064 patent and U.S. Patent No. 5,306,245 to Heaven (the Heaven '245 patent). The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

#### **B. The Cited References**

The Lundquist '064 patent discloses a variety of catheters. Referring to the catheter 501 illustrated in Figures 35B and 35C, the Lundquist '064 patent states:

Let it be assumed that it is desired to place a desired bend in the tractable or curve section 511b. This is accomplished by holding the catheter 501 in one hand and holding the tractable section 511b in the other hand and

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<sup>2</sup> Applicant notes for the record that the filing of a Terminal Disclaimer serves only to remove the obviousness-type double patenting rejection and raises neither a presumption, nor an estoppel, with respect to the merits of the rejection. See *Quad Environmental Technologies v. Union Sanitation District*, 20 USPQ2d 1393, 1394-95 (Fed. Cir. 1991).

grasping the tractable section 511b between two fingers of the other hand and placing a curvature or bend in the direction desired. This section 511b is tractable or malleable and retains at least a portion of the curvature or bend placed in the same primarily because of the malleability of the stainless steel used in that section. Thus, a preform is placed in the section 511b.

[Column 23, lines 50-61.] In other words, the Lundquist '064 patent discloses a catheter having a section that will hold its shape after being ***bent by the user***.

The Heaven '245 patent discloses a device including a tubular member 2, which is supported on a catheter 15, and a wire 8. The tubular member 2 includes a hinge 6 that is defined by a cutout 7. The hinge 6 causes the catheter 15 to bend in a single plane in response to the application of tension on the wire 8. Applicant respectfully submits that the tubular member 2 is not, as asserted in the Office Action, "biased to a predetermined curvature." [Office Action at page 4.] To the contrary, the tubular member 2 only bends in the manner illustrated in Figure 3 when tension is applied to the wire 8. [Column 5, lines 17-19.]

### C. Discussion

Independent claim 8 and 23 call for respective combinations of elements including, *inter alia*, "a main body portion ... including a preshaped portion having a predefined bend." The combination defined by claims 9, 11, 13, 14, 16 and 18-22 include, *inter alia*, the elements recited in claim 8, and the combinations defined by claims 25, 28 and 29 include, *inter alia*, the elements recited in claim 23. Applicant respectfully submits that the cited references fail to teach or suggest the claimed combinations.

For example, the Lundquist tractable section 511b is not preshaped and it does not have a predefined bend. Nothing in the Lundquist patent even remotely suggests that the tractable section 511b has any shaping prior to bending by the physician. Additionally, given the fact that the tractable section 511b is specifically designed to allow the physician to bend it however he or she sees fit (if it is bent at all), there is clearly no "predefined bend."

As the cited Lundquist '064 patent fails to teach or suggest each and every element of the respective combinations recited in independent claims 8 and 23, applicant respectfully submits that claims 8, 9, 11, 13, 14, 16, 18-23, 25, 28 and 29 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

Turning to claims 12 and 26, applicant respectfully submits that the Heaven '245 patent fails to remedy the aforementioned deficiencies in the Lundquist '064 patent with respect to independent claims 8 and 23. Claims 12 and 26 are, therefore, patentable for at least the same reasons as independent claims 8 and 23 and the rejection of claims 12 and 26 under 35 U.S.C. § 103 should also be withdrawn.

#### **IV. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

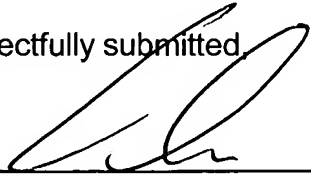
The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

4/19/04  
Date

**Henricks, Slavin & Holmes LLP**  
840 Apollo Street, Suite 200  
El Segundo, CA 90245  
(310) 563-1458  
(310) 563-1460 (Facsimile)

Respectfully submitted,

  
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Craig A. Slavin  
Reg. No. 35,362  
Attorney for Applicant